

Applicant: P. Bonutti  
Application No.: 10/755,995  
Examiner: D. Reip

### **Election/Restriction**

In accordance with the election requirement, Applicant provisionally elects, with traverse, the following species with reference to the categories set forth in the Office Action: Species 3, representative FIG. 10. Applicant notes that the Examiner acknowledges that at least claim 1 is generic.

The Examiner also required that Applicant select a "mode of fastening"; material; and select the material as being porous (or "open cellular") or non-porous; and coated or uncoated. Applicant hereby provisionally selects, with traverse, bi-lateral fastened (e.g. two screws), tantalum, porous, and coated with a bone growth promoting material.

In accordance with the Examiner's request, Applicant respectfully submits that claims 1-26 and 30-41 read on the elected species.

### **REMARKS**

Applicant has provisionally elected Species 3, with traverse. Further, Applicant has provided a list of all claims readable thereon.

Applicant traverses the election of the species requirement, as the restriction requirement is improper. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent; and (B) There must be a serious burden on the examiner if restriction is required. MPEP § 803. For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. (Id.) If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (Id.)

The Examiner has not demonstrated a serious burden by showing appropriate explanation of separate classification, or separate status in the art, or a different field of search. As such, the Examiner failed to provide a prima facie showing of a serious burden.

Furthermore, a review of the Manual of Patent Classification provides the following

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relevant classifications, namely, class 606 for surgery and subclass 60 is for internal fixation means, subclass 61 for spinal positioner or stabilizer, and subclass 99 for prosthesis insertor or extractor. The subject matter of each of the Examiner identified species, Species 1-9, would each individually require searching in the identified class and subclasses. Thus, regardless of whether all claims are examined together or separately, a review of class 606, subclasses 60, 61, and 99 is required.

As such, the search and examination can be made without a serious burden. Accordingly, an examination of all claims on the merits is required, even if the application includes claims to distinct or independent inventions. *See* MPEP § 803.

In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested. If any questions remain regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned. Please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket no. 780-A02-021-4).

Respectfully submitted,



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